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Richard P Berg  
Ladas & Parry  
5670 Wilshire Boulevard Suite 2100  
Los Angeles, CA 90036-5679

EXAMINER

PEREZ DAPLE, AARON C

ART UNIT

PAPER NUMBER

2154

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Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/806,960

Applicant(s)

HONG, DIXON

Examiner

Aaron Perez-Daple

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. This Action is in response to Preliminary Amendment filed July 7, 2001, which has been fully considered.
2. Claims 1-18 are presented for examination.
3. This Action is non-Final.

### ***Drawings***

4. Figure 1 is objected to because it fails to provide text labels. Text labels identifying the elements should be provided in addition to the numeric labels. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

5. The disclosure is objected to because of the following informalities: Section headings should be included. Paragraph numbers (beginning pg. 10) should be removed.  
Appropriate correction is required.
6. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

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- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or  
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

### *Claim Objections*

7. Claims 9 and 18 are objected to because of the following informalities: The claims are not in proper form for reciting an either/or format. The claims should be amended to recite -- in which the predetermined protocol or protocols comprise at least one of the set consisting of the Post Office Protocol (POP3) and the Internet Message Access Protocol (IMAP4)--. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. **Claims 1-18** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claims 1 and 10 recite that the user is “unable to specify” the server to which the user belongs. However, the claims require the user to enter their electronic mail (email) address. Because the domain provided in the email address is often sufficient to specify the server to which the user belongs, as noted by Applicant and further detailed in cited reference US 5,805,298 (see Figs. 4 and 5), it would appear that the user is, in fact, able to specify their server. Applicant should clarify exactly what information the user is unable to specify (for example, the user may be unable to specify the IP address of the server). For the purpose of applying prior art, very little patentable weight will be given to this limitation in the claims.
10. As for claim 10, “the Internet Domain System (DNS)” recited in lines 5-6 lacks proper antecedent basis.
11. As dependent claims, claims 2-9 and 11-18 suffer from the same deficiencies as claims 1 and 10.

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

13. **Claims 1 and 10** are rejected under 35 U.S.C. 102(a) as being anticipated by Ho et al. (US 5,805,298) (hereinafter Ho).
14. **Examiner's Note:** Ho discloses an email retrieval system for use over the internet which explicitly relies on DNS databases to provide routing information (col. 8, lines 7-17, "Upon establishment of...by the mailbox."). The concepts and background of DNS routing as well-known to those of ordinary skill in the art are provided in Stevens (W. Richard Stevens, "TCP/IP Illustrated, Volume 1: The Protocols," Reading, MA, 1994.) (hereinafter Stevens). Applicant is further referred to the discussions found in the Background sections of cited references US 6,121,095 and US 6,434,600 B2. These discussions demonstrate common uses for the basic concepts taught by Stevens in the context of email applications.
15. As for claim 1, Ho teaches a method of retrieving electronic mail for a user at a location remote from a server to which the user belongs but which the user is unable to specify, including the steps of: providing an access database containing records of servers supporting a specified electronic mail protocol or protocols (DNS database, col. 8, lines 7-17, "Upon establishment of...by the mailbox."); requiring from the user the electronic mail address and log-in password of the user (col. 2, lines 42-59, "In accordance with...each selected message."; col. 7, line 63 - col. 8, line 17, "A user wishing...by the mailbox."; Figs. 4 and 5); parsing the mail address to identify and remove the user identifier from the mail address and thereby obtain a presumed domain name of the user's server (col. 6, lines 57-61, "As seen in Fig. 5...at step 512."; step 402, Fig. 4); interrogating the access database to determine whether it contains a record of a server corresponding to the presumed domain name (inherent to DNS methods, see Stevens; col. 8, lines 7-17, "Upon establishment of...by the

mailbox.”); retrieving the record of any corresponding server thus identified as the server to which the user belongs (inherent to DNS methods, see Stevens; col. 8, lines 7-17, “Upon establishment of...by the mailbox.”); retrieving the user’s electronic mail from a server identified as the user’s server, and directing the mail to the user at the remote location (col. 8, lines 7-17, “Upon establishment of...by the mailbox.”).

16. As for claim 10, Ho teaches a system for retrieving electronic mail for a user at a location remote from a server to which the user belongs but which the user is unable to specify, including: an access database containing records of servers supporting a predetermined electronic mail protocol or protocols (DNS database, col. 8, lines 7-17, “Upon establishment of...by the mailbox.”); and a remote access client associated with the database and having access to the Internet Domain Name System (DNS) database and to a search engine associated with the protocol or protocols (client resides on communication device 100; col. 5, line 66 - col. 6, line 19, “The functions performed...compression/decompression routines.”); in which system the remote access mail client is arranged to require from the user the user’s electronic mail address and password, to parse the mail address to identify and remove the user identity from the mail address and thereby obtain a presumed domain name of the user’s server, to interrogate the access database to determine whether it contains a record of a server corresponding to the presumed domain name, and to retrieve the record of any corresponding server thus identified as the server to which the user belongs, to retrieve the user’s mail from any server identified as the user’s server and to direct it to the user at the remote location (Figs. 4 and 5; The recited database functions are inherent to DNS methods, as known to those of ordinary skill in the art.).

***Claim Rejections - 35 USC § 103***

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. **Claims 1-18** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ho et al.

(US 5,805,298) (hereinafter Ho) in view of Smith et al. (US 6,138,122) (hereinafter Smith) and in further of Stevens (W. Richard Stevens, "TCP/IP Illustrated, Volume 1: The Protocols," Reading, MA, 1994.).

19. As for claims 1 and 10, as interpreted under the 102 rejections above, the "access database" is anticipated by a typical DNS database known in the prior art and Ho is sufficient for meeting all the limitations of independent claims 1 and 10. However, claims 2 and 11 add additional limitations which appear to suggest that the "access database" is provided in addition to the typical DNS databases. As disclosed in the specification, the access database is local to the system hosting the remote access mail client (access database 1 and remote mail client 2 of Applicant's Fig. 1). The claims are not limited to this interpretation. However, under this interpretation, the Examiner finds that Ho does not specifically teach providing an additional "access database." Smith teaches providing an additional access database local to the ISP or access provider in order to speed resolution of the domain names the subscriber is trying to access (col. 1, lines 26-35, "In addition to...overall access speed.").



Ho teaches the use of an ISP or access provider for connecting to the internet (router 107, Fig. 1; col. 3, line 58 - col. 4, line 6, "The function(s) performed...of leased lines.").

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Smith by providing an additional access database local to the ISP or access provider in order to speed resolution of the domain names the subscriber is trying to access, as taught by Smith above.

20. As for claims 2-7 and 11-16, these claims recite specific steps which are well-known within DNS routing methods. It has already been noted above that these methods are inherent to Ho and specifically disclosed in Stevens (see pgs. 187-207 and 448-452). Because of their inherency, it is not necessary to provide a motivation for combining the references.

If it is interpreted that the access database is provided as a local DNS database in addition to the larger DNS system, as taught by Smith above, then the methods taught by Stevens can further be attributed to the access database. It would have been obvious to one of ordinary skill in the art to modify Ho by performing the specific methods of claims 2-7 and 11-16, because this would allow for efficient identification of the domain names, as taught by Stevens (see pgs. 187-207 and 448-452).

As for claims 3, 4, 12 and 13, see pgs. 201-202 and 448-452 of Stevens for a discussion of the use of MX queries which anticipates the claims.

As for claims 5 and 14, see pg. 190 of Stevens for a discussion of zone transfers that anticipates the claims.

Applicant is further referred to the discussions found in the Background sections of cited references US 6,121,095 and US 6,434,600 B2. These discussions demonstrate common uses for the basic concepts taught by Stevens in the context of email applications and are relevant to the specific methods recited in claims 2-7 and 11-16.

21. As for claims 8 and 17, neither Ho nor Stevens specifically teach dividing the database into first and second tables wherein the first table includes records of user's mail addresses and the address of the corresponding servers. However, Smith teaches a local server having tables for speeding up address resolution for sending and receiving email (col. 1, lines 26-35, "In addition to...overall access speed."). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Ho and Stevens by dividing the database into first and second tables wherein the first table includes records of user's mail addresses and the address of the corresponding servers in order to speed up address resolution, as taught by Smith above.
22. As for claims 9 and 18, Ho teaches the method according to claim 1 in which the predetermined protocol or protocols is or are the Post Office Protocol (POP3) and/or the Internet Message Access Protocol (IMAP4) (col. 7, lines 54-62, "Fig. 4 of the...Internet Activities Board.").

### ***Conclusion***

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 5,956,486, teaches client for receiving remote email; US 5,937,161, note email forwarding system; US 6,223,213 B1, note web-based email system; US 5,826,269,

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note Fig. 2; US 5,777,989, note host name resolution; US 6,185,551 B1, note web-based email system; US 6,119,171, note teaches local access database; US 6,026,441, note teaches resolution of domain names from parsed email address, see Fig. 2; US 6,434,600 B2, note background; US 6,131,095, note background.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Perez-Daple whose telephone number is 703-305-4897. The examiner can normally be reached on 9am - 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 703-305-8498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 4/27/04  
Aaron Perez-Daple

  
JOHN FOLLANSBEE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100